REMARKS

This Amendment is responsive to the Office Action mailed on June 7, 2004. By this Amendment, Applicants have amended Claims 1, 3, 6, 23-26, 51, 52, 56 and 57; have canceled Claims 30-47; and have added Claim 62. No new matter has been added.

I. Withdrawal of Claims 30-50

In the Office Action, the Examiner withdrew Claims 30-50 on the basis that these claims are directed to an invention that is distinct from the originally-presented invention. Applicants respectfully submit that the withdrawal of Claims 48-50 is improper, as independent Claim 48 is merely a rewritten version of originally-filed and allowed dependent Claim 10. Applicants pointed out the correspondence between Claims 10 and 48 in the remarks section of their prior Amendment:

> New independent Claim 48 includes all of the limitations of dependent Claim 10, as originally presented, including the base claim and all intervening claims. Because the Examiner indicated in the Office Action that Claim 10 was directed to allowable subject matter, Claim 48 and its dependent claims are believed to be allowable.

Because the Examiner has already found the subject matter of Claim 48 to be allowable, and because Claims 49 and 50 depend from Claim 48, Applicants request that the Examiner reinstate and allow these three claims.

II. Indefiniteness Rejection of Claim 1

Claim 1 stands rejected on indefiniteness grounds. According to the Examiner, the added language "by a server that is coupled to the personal computer by a network" fails to point out who or what is selecting the clickable icon file, and is not joined together with previous limitations to clearly point out a connection to the wallpaper desktop program.

In response to this rejection, Applicants have revised the relevant sub-paragraph of Claim 1 to include the following language: "wherein the clickable icon file is selected by a program module that runs on a server and communicates with the wallpaper desktop program over a computer network." In view of this amendment, Applicants request that the Examiner withdraw the indefiniteness rejection.

III. Obviousness Rejection of Claims 1-10, 23-28 and 51-59

The Examiner rejected Claims 1-10, 23-28 and 51-59 on obviousness grounds as being unpatentable over Chrabaszcz (USPN 6,101,529) in view of Straub et al. (USPN 5,905,492), in further view of George et al. (USPN 5,978,648). Applicants will refer to these references collectively as "the applied references." For the reasons set forth below, Applicants request that the obviousness rejection be withdrawn.

Independent Claim 1

By the foregoing Amendment, independent Claim 1 has been amended to clarify that the recited clickable icon file is selected by a program module that runs on a server (as opposed, e.g, to being selected by the user). In addition, the claim has been amended to clarify that this selection is made based, at least in part, on a profile of the user.

The applied references do not disclose or suggest these limitations of Claim 1. In this regard, the portion of George et al. relied on by the Examiner—namely Figure 9 and the associated description at col. 8—involves profile menu options 136 that are selectable by a user. These menu options are not "selected based, at least in part, on a profile of a user," and are not "selected by a program module that runs on a server." Because the applied references do not disclose or suggest these limitations, the rejection of Claim 1 is improper and should be withdrawn.

Applicants also respectfully submit that the rejection of Claim 1 is improper because the Examiner has not identified a suggestion or motivation, in the prior art, to combine George et al. with either Chrabaszcz or Straub et al. In this regard, George et al does not involve desktop wallpaper, but rather involves the very different area of performance assessment tools for students. Consequently, one seeking to develop an improved system for providing desktop wallpaper on personal computers would not have considered George et al's teachings. The Examiner's assertion that it would have been obvious to incorporate George et al's icons into the displays of Chrabaszcz does not address this issue, and is not supported by any of the applied references.

For the foregoing reasons, Applicants request that the Examiner withdraw the rejection of Claim 1.

Dependent Claims 2-5 and 23-28

Claims 2-5 and 23-28 depend from Claim 1, and are therefore patentable over the applied references for the reasons set forth above. In addition, these dependent claims recite limitations that provide additional patentable distinctions over the applied references.

For example, Claims 23-25, respectively, require the clickable icon file to be selected based, at least in part, on "wallpaper preference data of the user" (Claim 23), "a wallpaper image download history of the user" (Claim 24), and "wallpaper search criteria specified by the user" (Claim 25). The applied references do not disclose or suggest these limitations.

Independent Claim 6

With respect to independent Claim 6, Applicants submit that the obviousness rejection is improper because the applied references do not disclose or suggest the following claim limitations: "when said clickable icon is activated, said desktop program causes the personal computer to access a predetermined web site on the Internet that provides an option to purchase an item associated with said wallpaper image." The Examiner did not address these limitations in his rejection.

To the extent the Examiner is relying on George et al in rejecting Claim 6, Applicants also submit that the rejection is improper due to the absence of a suggestion or motivation to combine the references, as set forth above.

For the foregoing reasons, Applicants request that the Examiner withdraw the rejection of Claim 6.

Dependent Claims 7-10

Claims 7-10 depend from Claim 6, and are therefore patentable for the reasons set forth above for Claim 6. In addition, these claims recite limitations that provide additional patentable distinctions over the applied references. For example, none of the applied references discloses or suggests "transmitting to the personal computer a notice that additional wallpaper images are available for downloading to the consumer's personal computer," as recited in Claim 8.

Independent Claim 51

By the foregoing amendment, Claim 51 has been amended to clarify that the clickable image is selected "programmatically by a computer based, at least in part, on user profile data." As discussed above, the applied references do not disclose or suggest this feature in the context of the other claim limitations.

The applied references also fail to disclose or suggest "embedding the clickable image within the wallpaper image by combining file code of the clickable image file with file code of the wallpaper image file, to generate a modified wallpaper image that includes the clickable image." As discussed above, an important aspect of this feature is that it inhibits removal of the icon, or other clickable image, from the desktop by the user. In contrast, prior art methods for displaying desktop icons ordinarily involve superimposing or overlaying the icon on the wallpaper image, such that the icons can be removed from the desktop without switching to a different wallpaper image.

For these reasons, and because no suggestion has been identified in the prior art for combining George et al with Chrabaszcz and/or Straub et al, Claim 51 is patentably distinct from the applied references.

Dependent Claims 52-59

Claims 52-59 depend from Claim 51, and are therefore patentable for the reasons set forth above for Claim 51. In addition, these dependent claims recite limitations that provide additional patentable distinctions over the applied references. For example, none of the applied references discloses or suggests selecting the clickable image to embed in the wallpaper based, at least in part, on "a wallpaper image download history of a user" as recited in Claim 56, or on "wallpaper image search criteria" as recited in Claim 57.

III. Obviousness Rejection of Claims 21, 22, 29, 60 and 61

The Examiner rejected Claims 21, 22, 29, 60 and 61 on obviousness grounds as being unpatentable over Chrabaszcz in view of Straub et al., in further view of Spanga et al (USPN 6,587,837). Applicants submit that these claims are patentable in view of their respective dependencies from allowable independent claims.

In addition, Applicants submit that Chrabaszcz, Straub et al. and Spanga et al do not disclose or suggest the limitations added by these claims. For example, none of these references discloses or suggests displaying, with a wallpaper image, an icon that can be activated by a user to access a web site that provides an option to purchase a hard copy of the wallpaper image (Claim 21), or a physical poster or a print containing the wallpaper image (Claim 22). Nothing in Spanga et al would have suggested adding these features to Chrabaszcz's system.

IV. Objection to Claim 52

In response to the Examiner's objection, Claim 52 has been amended to remove the language "generally unremovable." The new language is supported by the text at the bottom of page 28, and the top of page 29, of the originally filed application.

V. Conclusion

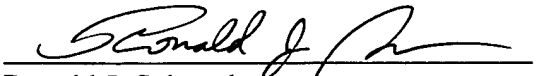
In view of the foregoing amendments and remarks, Applicants submit that the rejected claims are patentably distinct from the references applied by the Examiner, and request that the application be allowed with all of the rejected claims and with withdrawn Claims 48-50. By focusing on specific claims and claim limitations in the discussion above, Applicants do not imply an agreement with the Examiner's positions with respect to other claims and claim limitations.

If any issues remain which can potentially be resolved by telephone, the Examiner is requested to call the undersigned attorney of record at the number listed below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 11-8-04

By: 

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